

Attorney Docket No. P66531US1
Application No.: 10/014,446

Remarks/Arguments:

Claims 15-31, presented hereby, are pending.

Claims 8-14 are cancelled, hereby, without prejudice or disclaimer.

Present claim 15 corresponds to claim 8, amended by deleting reference to the non-expanded, expandable hollow spheres and by adding the limitation "the inner surface of the polyurethane layer is intended for direct contact with a roller," as described in the present specification at page 2, lines 23-24.

Present claims 16, 17, and 22 correspond to claims 9, 10, and 13, respectively, amended to be dependent on claim 15. Claims 18 and 19, which depend on claim 15, contain subject matter found in claim 11. Claims 20 and 21, which depend on claim 15, contain subject matter found in claim 12.

Method claim 23 corresponds to claim 14, rewritten as an independent claim, as discussed, below.

Claim 24 defines the polyurethane-layer-containing "rubber blanket" of the subject invention, such as disclosed at page 3, lines 20-24, of the instant specification. Claims 25, 26, and 31, which depend on claim 24, contain subject matter of claims 9, 10, and 13, respectively. Claims 27 and 28, which depend on claim 24, contain subject matter found in claim 11. Claims 29 and 30, which depend on claim 24, contain subject matter found in claim 12.

In accordance with the Office Action, the objection to claim 14 is overcome, hereby, by rewriting claim 14 as an independent claim, i.e., claim 23.

Attorney Docket No. P66531US1
Application No.: 10/014,446

In accordance with the presently claimed method (claim 23), "expanded thermoplastic hollow spheres" are present in the "freshly prepared mixture" used to make the "compressible polyurethane layer." Optionally, the "freshly prepared mixture" includes thermoplastic hollow spheres in their "non-expanded" state. However, these optional, non-expanded hollow spheres are expanded during preparation of the compressible polyurethane layer and, so, the final product contains only expanded thermoplastic hollow spheres.

Claims 11 and 12 were rejected under 35 USC 112, second paragraph, as allegedly being indefinite. Reconsideration is requested in view of the changes to the claims effected, hereby.

According to the statement of rejection, each of claims 11 and 12 is indefinite for reciting a range within a range. Since the range-within-a-range language is not found in any of the present claims, the rejection is overcome and, so, withdrawal of the rejection is in order.

Claims 8-14 were rejected under 35 USC 112, second paragraph, for allegedly being indefinite, based on the recitation of "and/or" in the claims. In that "and/or" is not found in any of the present claims, the rejection is overcome and, so, in order for withdrawal.

Claims 8-14 were rejected under 35 USC 102(e) as allegedly being anticipated by US 6,287,638 (Castelli). Reconsider is requested in view of the aforesaid amendments to the claims, taken in conjunction with the following remarks.

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The absence from a prior art reference of a single claim

Attorney Docket No. P66531US1
Application No.: 10/014,446

limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation. *Jamesbury Corp.* To anticipate the claim, each claim limitation must "*identically appear*" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

The statement of rejection relies on Castelli, col. 2, lines 54-62, col. 4, line 35-6, line 47, and col. 9, line 54, col. 10, line 46, to support the allegation that the rejected claims are fully met by the reference, i.e., each and every claim limitation, as arranged in each claim, is allegedly found in the reference.

In accordance with the presently claimed invention, "the inner surface of the polyurethane layer is intended for direct contact with a roller." The void-containing, polyurethane layer of Castelli does not have *an inner surface intended for direct contact with a roller*.

The void-containing, polyurethane layer of Castelli is an "intermediate layer" of Castelli's "laminated printing blanket," i.e., it is sandwiched between "a base ply and a surface layer" of the blanket (Castelli col. 3, lines 39-48). In accordance with Castelli (col. 3, lines 63-66):

The final laminated printing blanket comprises at least one base ply, a printing or "working" surface layer and an intermediate compressible layer positioned therebetween.

As explained, above, the present claims contain the limitation "the inner surface of the polyurethane layer is intended for direct contact with a roller," which limitation is absent from

Attorney Docket No. P66531US1
Application No.: 10/014,446

Castelli. A limitation on the present claims being absent from Castelli, anticipation of the present claims by the reference is negated. *Kolster Speedsteel A B, supra*. Accordingly, the rejection of record under 35 USC 102(e) is in order for withdrawal.

Moreover, the subject matter of rejected claim 10 (and present claims 17 and 26) is independently patentable over Castelli. The limitation added by claim 10 is an allegedly *inherent* feature of Castelli, i.e.,

the limitation of a thin surface layer of urethane at the materials['] surface [which] is seen to be *inherent* to the teachings of the cited reference as the microcapsules are mixed within the thermoplastic material[,] thus having thermoplastic material at the surfaces.

Office Action, page 4 (*emphasis added*). The rejection of claim 10 cannot be maintained because it relies on allegedly "inherent" disclosure of a claim limitation, which reliance on *inherency* is misplaced.

For the doctrine of inherency to apply it must be "*inevitable*" from the teachings of the prior art. *In re Wilding*, 190 USPQ 59, 62 (CCPA 1976) (*emphasis added*). "In relying on a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (*emphasis in original*). Before "the burden shifts," the examiner has "the initial burden of establishing a *prima facie* basis for the alleged inherency." 17 USPQ2d at 1463-64. To base a rejection on what is allegedly inherent in the reference teachings,

Attorney Docket No. P66531US1
Application No.: 10/014,446

the examiner must . . . reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the applied prior art.

17 USPQ2d at 1464 (*emphasis in original*). An argument by the PTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). When the

PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears *in the reference*. . . . The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient to establish inherency.

28 USPQ2d at 1557 (*emphasis added*).

The "thin layer of polyurethane towards the outer surface" recited in claim 10 (and present claims 17 and 26) contains either "non-expanded hollow spheres" or "no hollow spheres," at all. This is opposed to the main "polyurethane layer" of the of the present claims, which is *required* to contain "expanded hollow spheres." In other words, there are two, different types of spheres – expanded and non-expanded – in claim 10.

In contrast, there is only one type of "void" in Castelli. If, as alleged in the statement of rejection, the "voids" in Castelli meet the "expanded hollow spheres" of the present claims, the voids in Castelli cannot be "non-expanded." There is no description in Castelli, express or inherent, of two, different voids – one of which is expanded, the other being non-expanded. The alleged inherency of "having thermoplastic material at the surfaces" because "the microcapsules are mixed within the thermoplastic material" (Office Action page 4) amounts to unsupported argument, which fails to establish the allegedly inherent feature. Argument, alone, fails to reasonably support the

Attorney Docket No. P66531US1
Application No.: 10/014,446

determination that the allegedly inherent characteristic *necessarily* flows from the applied prior art. *Levy*, 17 USPQ2d at 1464 (*emphasis in original*). An argument by the PTO is "not prior art." *Rijckaert*, 28 USPQ2d at 1957.

Present claims 22 and 31 are independently patentable over Castelli. In each of claims 22 and 31 the "inner surface" of the polyurethane layer "is in contact with a carrier made of metal or plastic." The "carrier" forms, e.g., the substrate on which the polyurethane layer is cast, as described in the present specification (page 3, lines 25-29). In any event, the polyurethane layer cannot be fixed to the carrier; it is implicitly removable from the carrier since the polyurethane- layer surface in contact with the carrier is, also, "intended for direct contact with a roller." Castelli describes no "carrier," as found in the present claims.

In accordance with Castelli only permanent contacts are formed with both surfaces of the compressible polyurethane layer. The surfaces of polyurethane layer are only taught to be in *fixed* contact, i.e., with the adjacent layers of the rubber blanket. Since the "carrier" limitation in each of claims 22 and 31 is absent from the reference, anticipation of the claims by the reference is negated, *Kolster Speedsteel A B, supra*, and, so, the rejection of record under 35 USC 102(e) cannot be applied against present claims 22 and 31.

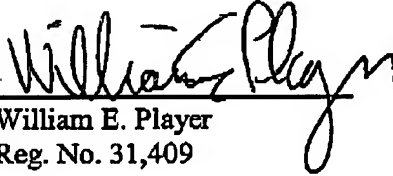
Attorney Docket No. P66531US1
Application No.: 10/014,446

Favorable action is requested.

Respectfully submitted,

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Date: February 10, 2004
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